

Hearing:
July 30, 1997

Paper No. 34
JQ

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

DEC 4, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Neostrata Company, Inc. and Herald Pharmacal, Inc.
v.
Neoteric Cosmetics, Inc.

Opposition No. 87,789
to application Serial No. 74/189,267
filed on July 29, 1991

Peter W. Peterson and Raymond A. Nuzzo of DeLio & Peterson
for Neostrata Company, Inc. and Herald Pharmacal, Inc.

David Wolf, Jenifer Paine and Robert E. Rigby, Jr. of Wolf,
Greenfield & Sacks for Neoteric Cosmetics.

Before Seeherman, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Neoteric Cosmetics,
Inc. to register the term ALPHA HYDROX for "cosmetics,
namely, skin lotions."¹

Registration has been opposed by NeoStrata Company,
Inc. and Herald Pharmacal, Inc.² As grounds for

Opposition No. 87,789

opposition, opposers assert that the term sought to be registered, when applied to cosmetics which include, as an ingredient, alpha hydroxy acids, is generic. Alternatively, opposers assert that the term is merely descriptive.

Section 2(e)(1) of the Trademark Act, 15 USC §1052(e)(1).

Applicant, in its answer, denied that the designation sought to be registered is either generic or merely descriptive.

The record includes the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; portions of a discovery deposition (with related exhibits), excerpts from printed publications, and applicant's answers to certain requests for admissions, all introduced by way of opposers' notice of reliance; and each opposer's responses to certain of applicant's interrogatories, and portions of a discovery deposition,³ all made of record in applicant's notices of

¹ Application Serial No. 74/189,267, filed July 29, 1991, alleging a bona fide intention to use the mark in commerce.

² In their brief opposers indicate that Allergan, Inc. acquired the assets of Herald Pharmacal, Inc. on August 3, 1995. In the absence of formal documentation, the Board has not taken any action relative thereto (such as joinder or substitution).

³ Opposers relied upon portions of the discovery deposition it took of Mark Goldstein, applicant's president and chief executive officer. Applicant has relied upon other portions of the same deposition which, according to applicant, should in fairness be considered so as to make not misleading what was offered by opposers. Trademark Rule 2.120(j)(4). We agree with applicant on this point.

reliance. Both parties filed briefs and both were represented by counsel at an oral hearing before the Board.⁴

The Parties

Opposers are engaged in the marketing and sale of skin care cosmetics, some of which contain alpha hydroxyethanoic acid as an active ingredient. NeoStrata Company, Inc. sells its product under the mark NEOSTRATA, and Herald Pharmacal, Inc. sells its product under the marks HERALD and M.D. FORMULATIONS. Some of Herald's products are sold only by dispensing physicians.

Applicant is engaged in the business of selling skin care products. Since introducing its first skin lotions sold under the term ALPHA HYDROX in 1992, applicant has expanded its product line to include a full range of skin care cosmetics. The products, all sold under the term ALPHA HYDROX, include face cleansers, facial treatments and

⁴ Applicant, in its answer and in its brief, contends that ALPHA HYDROX is neither generic nor merely descriptive. In the later portion of its brief, applicant also contends that even if the term ALPHA HYDROX were merely descriptive, the record establishes that the term has acquired distinctiveness pursuant to Section 2(f) of the Act. Applicant, in its brief, addresses in detail the evidence bearing on this issue. Opposers, in their reply brief, respond on the merits to applicant's claim, contending that the record is insufficient to show acquired distinctiveness.

Although applicant did not plead acquired distinctiveness as an affirmative defense, opposers have not objected to the interjection of the claim at the briefing stage, but rather have addressed it on the merits.

Inasmuch as it appears that the issue was tried by the parties as contemplated by Fed. R. Civ. P. 15(b), and since opposers have not objected thereto, we shall treat the issue of acquired distinctiveness as if it had been raised in the pleadings.

moisturizers, body lotions, body wash treatments, foot care treatments and after shave treatments. Applicant's products are sold in the mass market at places such as drugstores, discount stores, grocery stores and pharmacies. The products are advertised on a national scale on television, and in magazines and newspapers. Applicant has enjoyed considerable success with its product which, according to applicant, is the top-selling product in the specific market segment of skin care cosmetics having alpha hydroxy acid as an ingredient. Applicant also has expended significant sums in promotional efforts.⁵

The Issues

The issues to be determined in this case are (1) whether applicant's term ALPHA HYDROX is a generic name of its goods; (2) if not, whether the term, as applied to applicant's goods, is merely descriptive of them; and (3) if so, whether the term has become distinctive of applicant's goods in commerce.

The Goods

In order to properly consider the issues in this case, it is necessary to understand the specific type of product for which registration of ALPHA HYDROX is sought. Applicant's skin lotions contain as an active ingredient an

organic chemical called alpha hydroxyethanoic acid, generally referred to as "alpha hydroxy acid" or "AHA." According to Joseph Lewis, a director of research and development for Herald (now Allergan), alpha hydroxy acids are organic carboxylic acids with a hydroxy or alcohol group on the carbon, adjacent to the carboxylic group. The term "hydroxy" denotes the presence of a hydroxyl or alcohol group, and the term "alpha" denotes the location of this group, that is, on the carbon adjacent to the functional group. Alpha hydroxy acids in cosmetics serve as a mild skin peel, working to loosen and slough off dead skin cells to expose newer, fresher skin. Skin treated with alpha hydroxy acids appears softer and smoother, and age spots and freckles also appear to fade. The alpha hydroxy acids are derived from sugar cane, apples, grapes, citrus fruits and sour milk. Alpha hydroxy acids are available in cosmetics sold over the counter, such as opposers' and applicant's, in mild strengths (around ten percent or less). Dermatologists prescribe alpha hydroxy acids in lotions with concentrations of up to seventy percent.

With "baby boomers" and others viewing cosmetics having alpha hydroxy acid as anti-aging products for their skin, sales have skyrocketed. Mr. Goldstein testified that

⁵ The specific sales and advertising figures cannot be disclosed in this opinion inasmuch as they have been designated "confidential" by the parties pursuant to their agreement.

cosmetics having alpha hydroxy acids form a defined segment of the cosmetic industry (dep., p. 39). The presence of such products on the market has led to great growth in the skin care industry.⁶ The marketplace is full of directly competitive products, Mr. Goldstein's saying that there are over 100, with every manufacturer in the skin care industry having a product containing alpha hydroxy acid. Mr. Lewis testified that alpha hydroxy acid is the most popular skin care ingredient in cosmetics in the world. His testimony is buttressed by numerous articles which attest to the huge popularity of skin care cosmetics that contain alpha hydroxy acids. The evidence leaves no doubt that consumers in the marketplace can be expected to be familiar with alpha hydroxy acids and their purported benefits as ingredients in skin care cosmetics.

Testimony

The record includes the testimony of Joseph Lewis, as noted above, and Louis Semento, a former president, now retired, of NeoStrata. Both have backgrounds in chemistry.

⁶ Applicant's exhibit no. 220 is an excerpt from a printed publication in the March 1995 issue of *DCI*. The article is captioned "The AHA Phenomenon Continues", and the author indicates that there is no better way to describe alpha hydroxy acids and their effect on the cosmetic industry. The article quotes the *Wall Street Journal*: "AHAs can be credited with reviving the fortunes of the stagnant cosmetic industry," calling AHAs "the greatest advance the industry has ever seen." The article goes on to indicate that nearly all of the recent growth in the skin care cosmetic industry is attributable to the use of alpha hydroxy acids.

In addition, opposers offered the testimony of Leonard Milstone, M.D., professor of dermatology at Yale University School of Medicine and chief of dermatology at the VA Medical Center, West Haven, Connecticut.

Mr. Lewis testified that he has seen the word "hydrox" used in the same way as "hydroxyl." Mr. Semento also testified that the term "hydrox" may be used in place of "hydroxy" to denote a hydroxyl group in a chemical compound. Dr. Milstone stated that the term "hydrox" chemically means the same thing as "hydroxy."

Mr. Lewis further testified that he immediately recognizes the term "Alpha Hydrox" to be equivalent to the term "alpha hydroxy." His opinion is that consumers would also recognize the two as equivalents, pointing out as follows: "There's only a one letter difference between the two names. I mean they're practically identical. I think the lay consumer is not going to understand the difference whether you have a "Y" or not on the end of hydrox." (dep., p. 27)

Dr. Milstone also offered testimony bearing on the equivalency of "Alpha Hydrox" and "alpha hydroxy" (dep., pp. 17-18):

Q. Do you understand the term Alpha Hydrox to be a shortened form of alpha hydroxy?

A. I assumed that. I didn't know for certain. That was an assumption.

Q. Do you have any opinion as to whether other dermatologists would recognize the term Alpha Hydrox to be a shortened form of alpha hydroxy?

A. I would suspect so.

Q. What's the basis of your opinion?

A. Well, there are numerous examples in medicine and medicine prescribing where names of chemicals are shortened or changed slightly to make that easier to remember and I just assumed this was that kind of change.

Q. Do you have an opinion as to whether your patients would recognize the term Alpha Hydrox to be a shortened form of alpha hydroxy?

A. I would suspect so.

Q. And what's the basis for your opinion?

A. Similar to the basics for why I think physicians would do it, except I think in the general public there's a misunderstanding of chemical usage and people easily mistake one closely sounding name for another.

Dr. Milstone further testified regarding the use of "alpha hydrox" and "alpha hydroxy" (dep., pp. 23-25):

Q. Now, you said that you viewed a number of dermatological articles in the course of your practice. Have you brought any of them here with you?

A. No.

Q. Have you any—

A. There were some that were part of the folder that I have seen. I didn't bring that with me, though.

Q. And they all refer to the--the ones you are referring to identify alpha hydroxy acid as an active compound in treating certain skin disorders?

A. Yes.

Q. Did any of them use the term "alpha hydrox" as distinguished from "alpha hydroxy acid" that you can specifically recall?

A. Not that I remember.

Q. You can't recall any particular one that used the term "alpha hydrox"--

A. No.

Q. --in place of "alpha hydroxy acid"? In fact, the term is "alpha hydroxy acid," it's not "alpha hydroxy," is that correct?

A. That's right.

Q. And so you did not expect anyone to use the term "alpha hydroxy," you would expect in the dermatological field "alpha hydroxy acid"?

A. Correct.

Q. That would be the active compound you wanted to identify?

A. Certainly.

Q. In fact, you yourself don't use "alpha hydroxy" to describe "alpha hydroxy acids," do you?

A. No.

Q. You didn't at any time in this deposition, did you?

A. That's right.

Q. Any you certainly don't use "alpha hydrox" to describe "alpha hydroxy acids," do you?

Mr. Lewis testified that the term "alpha hydroxy" is commonly used in the cosmetics industry to describe alpha hydroxy acids used in cosmetics. Mr. Lewis stated that many companies in the industry use the term "alpha hydroxy" without the term "acid" because of potentially negative associations with the term "acid" when used in connection with skin care products.

Dictionary Evidence

Webster's Third New International Dictionary (1964)

includes the following listing:

hydroxy- or **hydrox-** *comb form* [ISV, fr. *Hydroxyl*, fr. E]: hydroxyl: containing hydroxyl esp. in place of hydrogen--in names of chemical compounds or radicals (*hydroxyalkyl*) (*hydroxamic acids*)--compare HYDROXO-

Examples given by opposers where "hydrox" is used as a prefix designating a hydroxyl group in a chemical compound are: hydroxamic acid, hydroxamethocaine, hydroxocobalamin and hydroxocobemine.

There are no dictionary listings of record for the terms "Alpha Hydrox" or "alpha hydroxy."

Applicant's Statements

In the record is a document captioned "SALES PRESENTATION [for] Alpha Hydrox Skin Treatment." Mr. Goldstein testified in his discovery deposition that he wrote and edited substantial portions of the document. The purpose of the document, according to Mr. Goldstein, was to provide applicant's sales people with information on the product, the product's benefits, the advertising and the general consumer market for cosmetic skin care items. Mr. Goldstein testified that the document was not seen by any retailers or customers. He did indicate, however, that some of applicant's regional managers shared the document with some of the broker agents who represent applicant's products. Opposers highlight three instances in the sales presentation document in support of their claim that applicant itself has acknowledged the genericness of the term sought to be registered:

These natural products contain substances known as Alpha Hydroxyacids (hence our name Alpha Hydrox), which are ideal for cosmetic use.

Alpha Hydroxyacids have been used and recommended by dermatologists for years. We will provide an easy means of purchase for their patients. Our generic name will further identify our product and take advantage of the awareness of this scientific breakthrough.

Several other manufacturers have been researching Alpha Hydroxyacids, and probably will launch new products with AHAs shortly. Up until recently,

existing patents have kept other manufacturers from taking advantage. Neoteric Cosmetics, Inc. will continue to grow even after competitive introductions because of the generic nature of its brand name: ALPHA HYDROX.

In a letter from Mr. Goldstein to prospective sellers of the product, he stated: "Taking its name from the active ingredient, we are introducing **ALPHA HYDROX Skin Treatment.**" [emphasis in original]

Competitors' Uses

The evidence shows that most competitors use the term "alpha hydroxy acid" or "alpha hydroxyacid" when naming the ingredient in their products. There are examples, however, where competitors have used simply "alpha hydroxy," as for example, "Alpha Hydroxy Face Lotion." The record is completely devoid of any uses by competitors of "Alpha Hydrox," and opposers' witnesses testified that they were not aware of any uses other than applicant's.

There also are exhibits (packaging or containers) showing competitors' referring to ALPHA HYDROX as a trademark: "COMPARE TO ALPHA HYDROX®"; "COMPARE OURS TO **ALPHA HYDROX®**", indicating that "ALPHA HYDROX is a registered trademark of [applicant]"; and "Compare to Alpha Hydrox™ Cream."

Media Uses

The record is replete with articles appearing in printed publications wherein the term "alpha hydroxy" is used in a generic manner in connection with various skin care products. Although opposers submitted only three articles showing such use, several of the hundreds of articles relied upon by applicant show similar uses.⁷

Opposers introduced some examples where the media apparently has misused the term applicant seeks to register. Mr. Goldstein testified that "[t]here's been press articles where our name has been misdescribed, instead of Alpha Hydrox, as alpha hydroxy...." When confronted with certain exhibits during his cross examination, Mr. Goldstein acknowledged that in five of the articles the term "ALPHA HYDROXY" was used in place of "ALPHA HYDROX" when referring to applicant's product. Mr. Goldstein stated that this "will occasionally happen, certainly against our better wishes." When asked if he knew whether there were more instances of interchanging "alpha hydroxy" for "Alpha Hydrox" in the print media, Mr. Goldstein replied "I'm sure it's been done, but I don't recall any specific instance."

⁷ Applicant's hearsay objections to the articles introduced by opposers are overruled. As pointed out by opposers, the articles were not submitted to prove the truth of the matters asserted therein; rather, the articles were made of record for what they show on their face, that is, generic uses of "alpha hydroxy."

Other than in these five instances, the hundreds of other articles of record show reference to ALPHA HYDROX as a trademark of applicant.

Consumers' Uses

The record includes six "consumer profiles" which were returned to applicant in response to applicant's campaign to gather information about its consumer base. The six documents were selected by opposers out of 10,600 responsive documents.⁸ In filling out the profiles, six different consumers made the following statements:

Can you make your product with a higher percentage of alpha hydrox acid?

I want to try any new product you come out with containing alpha hydrox.

⁸ Opposers contend, in their reply brief, that applicant has not proved that the six responses were selected from a pool of 10,600 responses, and ask that the 10,600 figure be ignored.

Opposers' objection is overruled. Applicant, in responding to certain of opposers' requests for admission (which were propounded to establish the authenticity of the consumer profiles), stated as follows: "The document is one selected by Opposer from approximately 10,600 consumer response documents including over 600 consumer profiles which consumer profiles were received by [applicant] after February 2, 1993."

In our view, the 10,600 figure has been made of record by way of opposers' reliance on applicant's responses to certain of the requests for admissions. Other than the mention in their reply brief, opposers did not dispute the accuracy of this number or offer any contravening evidence or clarifying remarks (as, for example, that opposers inspected only one hundred profiles, or that the six profiles comprise a representative sample of numerous other profiles, or that less than the total number of profiles were made available to opposers). At the oral hearing, in response to the Board's inquiry on this point, opposers stated that they did not dispute the accuracy of the 10,600 figure.

My [question] was what is % of I hydrox. Acids in product...I shared information about magazine article just out re[garding] I hydrox acids...

...I have read that the Alpha Hydrox acids are the best thing to use...

I wanted to know what the difference was between your Alpha hydrox and the prescription of Alpha hydroxy Acid.

What is the difference between Alpha Hydrox and Neo Strata?

Survey Evidence

Applicant took the testimony of Robert Burgess, president of Marketing Advocates, Inc., a marketing consulting business specializing in marketing research. Mr. Burgess testified that he has thirteen years of experience in designing, conducting and implementing market research studies. Applicant commissioned Mr. Burgess and his company to implement a study in 1995 which, in Mr. Burgess' words, "was designed primarily as a way to track how the marketplace is reacting to the Alpha Hydrox brand, to understand the recall of the brand, how the advertising works, what the consumer perceptions are of that brand, and understand how the brand is distinguished from other products in the category." (dep., p. 8) Phase 1 of the "Alpha Hydrox Advertising Tracking Study" was completed in

December 1995 and presented to applicant in January 1996.⁹ Applicant points out that the survey was not done specifically to be used in this proceeding.

The survey is based on 200 completed telephone interviews of women buyers/users of facial skin care products, aged 30-72, who purchase those products at mass merchandisers on a regular or occasional basis. The surveys were evenly divided across six geographic areas (Indianapolis, Long Islan, Phoenix, Spokane, Orlando and Tampa).

While the Board is obliged to refrain from citing the specifics of the survey due to its confidential nature, the results show that ALPHA HYDROX, in terms of top-of-mind, unaided awareness, is the third most likely facial skin care brand name to pop up in the minds of the consumers interviewed. Although the raw percentage number is small, Mr. Burgess characterized this percentage of unaided brand awareness of applicant's ALPHA HYDROX as "significant."

Genericness Analysis

A term is generic if it names the class of the goods or services to which it is applied. See: H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986), and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed.

⁹ This study, offered as exhibit no. 557, has been designated by applicant as "confidential."

Cir. 1985). The test for determining whether a term is generic is its primary significance to the relevant public, that is, whether the term is used or understood, by purchasers or potential purchasers of the goods or services at issue, primarily to refer to the class of such goods or services. See: *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*; and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, newspapers, magazines, dictionaries, catalogs, and other publications. See: *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, *supra*, and *In re Northland Aluminum Products, Inc.*, *supra*.

Whether a term is classified as "generic" or as "merely descriptive" is sometimes, as in the present case, not easy to discern. *In re Merrill Lynch*, *supra* at 1142. Fine lines must be drawn and, in making our determination here, we readily concede that this is a close case.

The Category of Goods and the Relevant Public

In determining genericness, we must first identify the category of goods at issue. Although the involved application is based on an intention to use, applicant

commenced use of ALPHA HYDROX in 1992, and the record includes testimony and hundreds of exhibits relating to applicant's products sold under the term ALPHA HYDROX.

In this case, the category or type of product is clear: skin care cosmetics containing alpha hydroxyethanoic acids. Other acceptable names for the category are alpha hydroxyacid cosmetics or simply alpha hydroxy cosmetics.

Also clear is the relevant purchasing or consuming public for such products. Here, we find the relevant public to be ordinary consumers who are the end users of over-the-counter skin care cosmetics.¹⁰

That brings us to the harder question, as is so often the case when the issue is genericness: whether the term sought to be registered is understood by the relevant public primarily to refer to the class of the involved goods? Accordingly, in the present case, the ultimate question is whether the term ALPHA HYDROX is understood by consumers in

¹⁰ Opposers contend that the relevant purchasing public comprises "both the 'average' consumer who purchases the cosmetic product at retail stores as well as dispensing professionals such as physicians, dermatologists, plastic surgeons and licensed estheticians who may resell the products to patients and clients." (brief. p. 12) See discussion, *infra*. In citing to specific testimony and evidence, we find that opposers are taking liberty with those portions of the record. The record establishes that applicant's products have a low concentration of alpha hydroxy acid, and that they are sold over the counter to ordinary consumers. Applicant has not directly sold any products to physicians or other professionals. Thus, we agree with applicant that the relevant consumer is the ultimate, average consumer who buys over-the-counter skin care products.

the marketplace primarily to refer to the class of skin care cosmetics containing alpha hydroxy acids.

We find that petitioner, as the party making the charge of genericness, has not proved its claim by a preponderance of the evidence. *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993).

The record establishes that "alpha hydroxy" is a shortened and commonly used generic name for alpha hydroxy acid."¹¹ And, the difference between "Alpha Hydrox" and "alpha hydroxy" is the omission of only one letter, namely, the last letter "y". In this connection, we candidly recognize that the addition, deletion or change in one letter normally does not transform a generic term into a source indicator. See generally: 2 J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §12:38 (4th ed. 1998). However, as we view it, ALPHA HYDROX is neither the equivalent of "alpha hydroxy" nor a mere misspelling of "alpha hydroxy," let alone "alpha hydroxyacid." This slight variation is enough to take the matter sought to be registered out of the generic category. That is to say, our view is that the relevant purchasing public will notice the difference in syllables and the omission of the last letter "y" in applicant's term ALPHA HYDROX. The fact that the record shows that "hydrox" hardly ever has been used

separately other than as a part of applicant's term ALPHA HYDROX (the only exceptions of record being the few uses highlighted by opposers) suggests that applicant's term is unusual enough that consumers will perceive it as a trademark.

Although opposers' three witnesses testified that "hydroxy" and "hydrox" are equivalents and that "alpha hydroxy" is perceived to be equivalent to "Alpha Hydrox," such testimony and supporting exhibits fall short, when balanced against other evidence, in establishing what ultimate consumers primarily perceive when encountering ALPHA HYDROX. Opposers' witnesses, all with backgrounds in the field of skin care, are not "average" purchasers for the over-the-counter skin care products of the type sold by applicant.

In the case of *Magic Wand, Inc. v. RDB, Inc.*, supra, the Federal Circuit held that the test of whether "touchless" is a trademark for automobile washing services or is the generic name of a type of automobile washing service is its meaning to consumers who use the services, not its meaning to operators and manufacturers of automobile washing equipment even though they might also avail themselves of car washing services. While there was evidence of use of "touchless" as a generic name of a type

¹¹ In saying this, we note also that the record establishes that

of equipment by manufacturers and operators of commercial car wash equipment, there was no proof that the term was also used as a generic name by the general car-owning public in the market for car-wash services. In the court's words: "These vendors, operators and manufacturers [of car wash equipment] are a very small part of the relevant purchasing public. Accordingly, evidence of generic use by this small part of the relevant purchasing public has limited probative value." Id. at 1554.

We find a similar situation here. The fact that three persons (two of whom are intimately associated with opposers) with backgrounds in chemistry or dermatology have an opinion on the genericness of applicant's term ALPHA HYDROX is of limited help in deciding this issue. And, even assuming that the relevant purchasing public includes, as opposers suggest, dermatologists, plastic surgeons and licensed estheticians, this is a very small part of the relevant public for purposes of our analysis. Id.

on balance, what evidence there is of how others perceive ALPHA HYDROX leads us to conclude that it is not generic. In chemical nomenclature, it would appear that "hydrox" or "hydroxy" is used exclusively as part of the name of a chemical compound. There is no technical evidence showing use of "hydrox" or "hydroxy" alone, and there is no

the common abbreviation for "alpha hydroxy acid" is AHA, not AH.

technical evidence showing a chemical compound called either "hydrox" or "alpha hydrox." Mr. Lewis testified that he has never seen "hydrox" used as a separate word other than as used in applicant's ALPHA HYDROX. (dep., p. 37) In our view, the dictionary entry relied upon by opposers shows that "hydrox" is equivalent to "hydroxy" only when it is used in combination with the rest of a chemical compound name; ALPHA HYDROX is not the name of a chemical compound. Opposers' interrogatory responses relied upon by applicant reinforce opposers' lack of knowledge of any uses of "Alpha Hydrox" per se in a generic or descriptive manner by any one in the trade or in the media.¹²

Further, there is not even a single instance of a competitor in the trade using "Alpha Hydrox" in a generic manner. In point of fact, the evidence shows that when competitors compare their products to applicant's, their packaging specifically refers to ALPHA HYDROX as a trademark of applicant (two even erroneously referring to it as a registered trademark). We are not surprised that no one else has used the term as a generic name. We say this inasmuch as there would appear to be no competitive need to use "Alpha Hydrox" when one can freely use the generic

¹² In the same responses opposers went on to indicate that they were aware of such uses of "the equivalent term 'Alpha Hydroxy'."

"alpha hydroxy" or "alpha hydroxy acid" (or "alpha hydroxyacid").

In addition, there is not a single instance where applicant has used ALPHA HYDROX in a generic fashion. In saying this we recognize, of course, that applicant's sales presentation document suggests to readers that the term is generic. However, Mr. Goldstein, the person primarily responsible for preparation of the document, is not a trademark attorney and has not indicated that he understood or intended for his use of "generic" to have a legal connotation. Although the document obviously should have been more carefully drafted, the Board thinks it unreasonable to treat as an admission against interest "words of art" used in the statements of a non-lawyer without experience in using statutory language. Also, given Mr. Goldstein's testimony regarding the limited distribution of the sales presentation document, it is highly unlikely that any ultimate consumer in the marketplace, let alone an appreciable number of them, were exposed to the document.

The hundreds of uses of ALPHA HYDROX in the media are, but for a few minor instances highlighted by opposers, in the manner of a trademark. The proper uses capitalize the first letters "a" and "h" as in "Alpha Hydrox," and often refer to the term as the brand name of applicant's product. The fact that so few articles misused the term out of

several hundred articles made of record suggests that the misuse is relatively incidental and, nevertheless, the misuses are outweighed by the proper trademark uses of record. And, although Mr. Goldstein indicated that he suspected that there were more misuses, the simple fact remains that no more than a few have been introduced into the record of this case.

Likewise, the consumer profile cards, although relied upon by opposers, tend, we think, to weigh in applicant's favor. There is evidence of only six consumers out of a pool of 10,600 who misused applicant's trademark as a generic name. We can only assume, given that the consumer profile evidence was introduced by opposers, that the other 10,594 consumers (or, at the very least, an overwhelming number of them) did not misuse the trademark as a generic name. Cf. *In re Federated Department Stores, Inc.*, 3 USPQ2d 1541, 1542 at n. 2 (TTAB 1987) ["....we must assume that the three excerpts [out of eighteen] selected provide the best support of the Examining Attorney's refusal to register available from that source."]

Finally, the brand awareness survey, although clearly not the type of survey known as a "Thermos Survey"¹³ or a

¹³ *American Thermos Products Co. v. Aladdin Industries, Inc.*, 207 F.Supp. 9, 134 USPQ 98 (D. Conn. 1962), aff'd, 321 F.2d 577, 138 USPQ 349 (2d Cir. 1963), mot. denied, 289 F.Supp. 155, 159 USPQ 604 (D. Conn. 1968), vacated, 418 F.2d 31, 163 USPQ 65 (2d Cir.

"Teflon Survey,"¹⁴ is of some limited probative value here. Mr. Burgess testified that the brand awareness survey shows that applicant enjoys a "significant" degree of unaided awareness of its ALPHA HYDROX as a brand name. Although the survey is based on only 200 interviews, it tends to favor applicant's position that ALPHA HYDROX is perceived by the purchasing public primarily to refer to a source indicator rather than to a generic name.

In sum, we find that the record, on balance, falls short in proving genericness. Genericness is a fact-intensive determination and the Board's conclusion must be governed by the record which is presented to it. It is the record evidence about purchasers' perceptions that control the determination, not general legal rules or our own subjective opinions. While we candidly admit that we entertain doubts about the character of applicant's Here, opposers simply have not sustained their burden of proof with clear evidenc. Rather, the record comprises a mixture of uses, with the mixture heavily weighted in applicant's favor. The proofs fail to clearly place the term ALPHA HYDROX in the category of a generic term. In re Merrill Lynch, supra.

1969), on remand, 320 F.Supp. 1156, 166 USPQ 381, 169 USPQ (D. Conn. 1970).

¹⁴ E. I. Du Pont de Nemours & Co. v. Yoshida International, Inc., 393 F.Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975).

Mere Descriptiveness Analysis

A term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1), if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

Although the record falls short of proving genericness, we find, nonetheless, that the testimony and evidence establishes that the designation ALPHA HYDROX is merely descriptive as applied to skin care cosmetics containing alpha hydroxy acids. Simply put, ALPHA HYDROX immediately and directly conveys information about applicant's cosmetics, that is, that the cosmetics contain alpha hydroxy acids. Mr. Goldstein, when asked at his discovery deposition whether he "consider[ed] that the mark Alpha Hydrox conveys to consumers some sort of idea that the

[applicant's] product contains alpha hydroxy acids," replied "yes."

Acquired Distinctiveness

It is settled that whether a term has become distinctive is a question of fact that must be determined based on the evidence of record. *G. H. Mumm & Cie Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635 (Fed. Cir. 1990). Whether the quality and character of evidence is sufficient to prove distinctiveness is necessarily a subjective determination that depends to a large extent on the nature of the term and the circumstances surrounding the use of the term. *Roux Laboratories, Inc. v. Clairol, Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970). The ultimate burden of proving acquired distinctiveness in this case is on applicant who is seeking registration. *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

In the case of applicant's ALPHA HYDROX, the record shows that applicant has enjoyed significant success with its products sold under the mark. Mr. Goldstein testified that applicant's products sold under ALPHA HYDROX are usually the top-selling ones among alpha hydroxy acid products in the mass market. Applicant began using ALPHA HYDROX in 1992, and its use has been continuous since that time. Further, no one else other than applicant has ever

Opposition No. 87,789

used ALPHA HYDROX in connection with skin care cosmetics or alpha hydroxy acids. As noted earlier, we are not at liberty to disclose applicant's sales and advertising figures inasmuch as they were marked confidential. What we can say, however, is that the sales have been in the tens of millions (close to nine figures), with corresponding substantial sums spent on advertising (in the eight figures). Advertisements have run on national television and have appeared in printed publications with nationwide circulation. Applicant's products also have been featured in various national television news reports and in national print articles, both solicited and unsolicited. Except in a few isolated instances, the designation ALPHA HYDROX is referred to as a trademark of applicant. As evidenced by the survey results cited above, all of the exposure has resulted in a good degree of brand awareness of applicant's ALPHA HYDROX in the facial skin cosmetics field.

Further, as noted earlier in this opinion, the record shows that some competitors in the field refer on their packaging to applicant's ALPHA HYDROX as a trademark. Such comparative uses suggest that these competitors, as well as the customers for their products, recognize ALPHA HYDROX as a source indicator for applicant's competing products. We can only conclude that the comparison is made because

competitors recognize that the purchasing public is familiar with applicant's ALPHA HYDROX mark.

In view of applicant's exclusive and continuous use, significant sales and advertising expenditures, substantial publicity in the national media, and degree of brand awareness among competitors and consumers, we find that applicant has established acquired distinctiveness of its mark ALPHA HYDROX as applied to skin care cosmetics.

Conclusion

In summary, ALPHA HYDROX is not generic for skin care cosmetics containing alpha hydroxy acids. However, the record establishes that the term is merely descriptive under Section 2(e)(1), but also that the term has acquired distinctiveness as provided under Section 2(f).

In view of this disposition of the case, we are compelled to make additional comments in response to what appears to be a major concern of opposers. A recurring theme in opposers' briefs is that "registration of the term 'Alpha Hydrox' will prevent others from using 'Alpha Hydroxy' with alpha hydroxy cosmetics and skin lotions." Opposers claim that applicant, upon issuance of a registration to it, "would unfairly gain the prima facie exclusive right to the term 'alpha hydrox' and thus, a monopoly on the use of the term in connection with cosmetics and skin lotions." Opposers express their fears as follows:

Opposers and other competitors have the right to use either "alpha hydroxy" or "alpha hydrox" with products containing acids of the "alpha hydroxy" type. Registration of "Alpha Hydrox" will enable applicant to claim that opposers' and others use of the term "alpha hydroxy" in connection with alpha hydroxy acid cosmetics constitutes an infringement of applicant's rights in the mark "Alpha Hydrox" because of the similarity or equivalence of those terms in the perception of purchasers of alpha hydroxy acid cosmetics.

Opposers go on to cite a trademark infringement suit brought by applicant against a third party.¹⁵

In response, applicant states that "[registration of ALPHA HYDROX by Applicant would not prevent companies from using terms such as 'alphahydroxy' or 'alpha hydroxy' in whole or in part." (brief, p. 21) Moreover, the following exchange during Mr. Goldstein's testimony is illustrative of applicant's position on this point:

Q. Do any of your competitors use Alpha Hydrox as a trademark?

A. No.

Q. Do any of them use Alpha Hydrox in a descriptive sense?

A. No.

¹⁵ Opposers specifically point to exhibit 72, contending that applicant sued on the basis of its ALPHA HYDROX mark. However, a review of that exhibit, coupled with applicant's remarks at the oral hearing, would indicate that applicant's claim related to its alleged overall trade dress (a red rectangle box, white, black and silver lettering, etc. and which includes the term ALPHA HYDROX) rather than the word mark per se. See Goldstein dep., ex. no. 473.

Opposition No. 87,789

Q. Do any of them use alpha hydroxy alone or in combination?

A. Yes.

Q. And do you consider that use of alpha hydroxy to be an encroachment upon any trademark rights you may assert?

A. No.

Applicant reiterated its position at the oral hearing, indicating that it could not stop others in the trade from using the term "alpha hydroxy" in a generic or descriptive manner in connection with their competing products.

The record lacks evidence showing that applicant has filed a trademark infringement suit, based on asserted proprietary rights in the term ALPHA HYDROX alone, against anyone using "alpha hydroxy" either alone or in combination with other terms. In point of fact, to do so would be directly contrary to Mr. Goldstein's representation made *under oath*, as well as counsel's representations made to the Board in the brief and at the oral hearing.

Thus, we are inclined to view opposers' fear as unfounded. We see no competitive need to use the specific term ALPHA HYDROX and, indeed, the evidence shows that no one other than applicant has used the term as a generic or descriptive term. On the other hand, however, there is a competitive need to use the generic term "alpha hydroxy" and issuance of the registration sought by applicant will not

give applicant the right to interfere with the fair use (even in a prominent manner) by others of the term "alpha hydroxy" alone or in combination with other terms, as for example, "alpha hydroxy face lotion." Likewise, we do not envision the Office's refusing registration under Section 2(d) on the basis of applicant's registration when other entities might seek to register marks which include, in part, the generic term "alpha hydroxy" (which, of course, would be disclaimed).

Decision

The opposition is dismissed, and a registration under Section 2(f) will issue in due course.

E. J. Seeherman

E. W. Hanak

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board